

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of the Application for Registration of FIDELITY NATIONAL FINANCIAL (and design) in Classes 36, 37 and 42, Serial No. 76/180,913, filed on December 14, 2000 by Fidelity National Financial, Inc., published in the Official Gazette on December 10, 2002 at Page TM 103.

FMR CORP.

Opposer

v.

FIDELITY NATIONAL FINANCIAL, INC.

Applicant

Mark: FIDELITY NATIONAL
FINANCIAL (and design)

Ser. No. 76/180,913

Filed December 14, 2000

Opposition No.

NOTICE OF OPPOSITION

FMR Corp., a Delaware corporation located at 82 Devonshire Street, Boston, Massachusetts 02109 ("Opposer"), believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes the same as to the Class 36 services only.

1. Opposer has continuously used FIDELITY and other marks containing the word FIDELITY for mutual fund investment services, stock brokerage services and a range of other financial services ("Opposer's Services") since at least as early as 1930.

2. Opposer is the owner of over sixty federal registrations for marks consisting of or containing the word FIDELITY, including the following registrations, among others:

- Registration No. 1,543,851 for FIDELITY covering mutual fund services and stock brokerage services, dated June 13, 1989 and based on use of the mark since 1930.
- Registration No. 2,108,052 for FIDELITY covering financial publications, namely, magazines, brochures, newsletters and books, dated October 28, 1997 and based on use of the mark since 1930.
- Registration No. 2,469,578 for FIDELITY.COM covering financial services, namely, providing financial news, account information, retirement fund information, investment fund performance information and other information relating to investments, insurance, financial planning for retirement and other financial issues, all by means of a web site on a global computer network; financial planning services; investment account management services; retirement fund account management services; online securities brokerage services; mutual fund investment services; retirement fund investment services, dated July 17, 2001 and based on use of the mark since September 1996.
- Registration No. 1,486,454 for FIDELITY FUTURE RESERVES covering investment managing services for the insurance industry, dated April 26, 1988, and based on use of the mark since February 2, 1987.
- Registration No. 2,310,554 for FIDELITY INCOME ADVANTAGE covering financial services, namely, providing immediate variable annuities, dated January 25, 2000 and based on use of the mark since January 1993.
- Registration No. 1,941,928 for FIDELITY INVESTMENTS LIFE INSURANCE COMPANY (and design) covering insurance services, namely, issuing variable annuity life insurance policies, dated December 19, 1995 and based on use of the mark since February 14, 1992.
- Registration No. 2,273,928 for FIDELITY RETIREMENT RESERVES covering financial services, namely, providing deferred variable annuities, dated August 31, 1999 and based on an intent-to-use application filed on March 25, 1998.

Opposer's above-identified marks are hereinafter referred to as "Opposer's Marks."

3. Applicant's application Ser. No. 76/180,913 for FIDELITY NATIONAL FINANCIAL (and design) ("Applicant's Mark") is based on use of the mark since August 1, 2000, and covers the following services in Class 36 ("Applicant's Services"):

Title insurance services, namely agency, brokerage, underwriting, consultancy and information services for real property located within and outside of the United States; insurance services, namely agency, brokerage, underwriting, consultancy and information services for property, casualty, life and health insurance, and coordination of insurance transactions between agents; services for originating, closing and servicing real estate transactions for others, namely real estate evaluation, closing and settlement services, default title, property tax payment services, property tax delinquency processing services, financial disbursement processing services, real estate escrow and impounding services, credit reporting services, flood determination services, flood hazard compliance services, flood hazard certifications, property valuation and appraisal services and broker-priced opinion services, real estate loan default management services, posting, publication and auctioneering services for real estate foreclosures, trust management services, trustee's sale guarantee services, reconveyance services, loan portfolio services featuring document preparation and recording, mortgage lending services, mortgage assignment and release preparation services, services relating to advisory and management services for coordination of real estate owned, "reo", transactions for lenders and services, foreclosure and bankruptcy management services, and financial disclosure reporting services; services in the nature of acting as a qualified intermediary for tax-deferred exchanges for real and personal property; real estate services, namely providing relocation information to new home purchasers; real estate services for timeshare and resort properties, namely underwriting title insurance, underwriting title insurance policies, escrow services and real estate listings for resale, and foreclosure services; home warranty services; and commercial finance services, namely services for originating, funding, acquiring, selling, securitizing and servicing non-cancelable equipment leases for others.

4. Applicant's Mark is very similar to Opposer's Marks; Applicant's Services are closely related to Opposer's Services; the channels of trade employed by Opposer and Applicant are unrestricted; and the customers of Opposer and Applicant are unrestricted. The only significant difference is that Opposer has continuously used Opposer's Marks since well before Applicant began using Applicant's Mark.

5. Therefore, potential customers for Opposer's Services provided under Opposer's Marks are likely to become confused and

deceived when they see Applicant's marketing materials, whereupon they may avail themselves of Applicant's Services rendered under Applicant's Mark, believing that Applicant is associated or affiliated with Opposer. This likely confusion and deception harms Opposer.

6. If Applicant is granted the registration herein opposed, it would obtain thereby at least a prima facie exclusive right to the use of Applicant's Mark for Applicant's Services. Such a registration would be a source of damage and injury to Opposer and would wrongfully and improperly hinder not only Opposer's present use of Opposer's Marks, but also Opposer's rightful future use and registration of Opposer's Marks.

7. Applicant is not the owner of the mark shown in Serial No. 76/180,913 with respect to Applicant's Services because Opposer is the sole owner of Opposer's Marks and has granted no license, right or title in the same to Applicant. Therefore, Applicant is not entitled to the registration or the exclusive use of Applicant's Mark for Applicant's Services, because Opposer has the prior and exclusive right to the registration and use of Opposer's Marks.

WHEREFORE, Opposer prays that application Serial No. 76/180,913 be rejected as to the Class 36 services, and that registration of the mark shown therein sought for the Class 36 services therein specified be denied. A duplicate copy of this Notice of Opposition and the fee of \$300.00 are enclosed herewith.

CORRESPONDENCE ADDRESS

All correspondence in this matter should be addressed to:

I. Stephen Samuels
Samuels, Gauthier & Stevens LLP
225 Franklin Street, Suite 3300
Boston, MA 02110-2898
Tel. 617-426-9180 ext. 107
Fax 617-426-2275
Email ISS@samuelstM.com

DECLARATION

The undersigned declares that he is attorney for the opposer and is authorized to execute this notice of opposition and declaration on behalf of the opposer; that he has read and signed the notice of opposition and knows the contents thereof, that all statements made therein of his own knowledge are true and that all statements made therein on information and belief are believed to be true; and further that all statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document or this opposition.

Date: March 24, 2003

I. Stephen Samuels

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Registration No. 20,919
Samuels, Gauthier & Stevens LLP
225 Franklin Street, Suite 3300
Boston, MA 02110
Tel. 617-426-9180
Fax 617-426-2275
Email ISS@samuelsTM.com
Attorney for Opposer

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on March 24, 2003.

Date: March 24, 2003

Timothy H. Hiebert

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COPY

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Date: March 24, 2003

Timothy H. Hiebert

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THAB

3-26-03

SAMUELS, GAUTHIER & STEVENS LLP

ATTORNEYS AT LAW
PATENTS TRADEMARKS AND COPYRIGHTS

225 Franklin Street, Suite 3300
Boston, Massachusetts 02110

Tel: 617-426-9180 ext. 107

Fax: 617-426-2275



03-26-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

Commissioner for Trademarks
Attention: Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, VA 22202-3513

Re: **Trademark Opposition**
FMR Corp.
v.
Fidelity National Financial, Inc.
Mark: FIDELITY NATIONAL FINANCIAL (and design)
Ser. No. 76/180,913
Filed December 14, 2000

Dear Madam:

Enclosed please find Opposition papers submitted in duplicate together with a check in the amount of \$300.00 to cover the filing fee for an opposition as to one class of services. We request that the Opposition be instituted as to Class 36 only, and that notification be sent out as to the answer date.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayments, to our Deposit Account No. 501427. A duplicate copy of this letter is enclosed.

Sincerely yours,

I. Stephen Samuels

I. Stephen Samuels
Attorney for Opposer

Enclosures

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Handwritten signature